

Appl. No.09/512,425

Reply to Office Action of November 22, 2005

REMARKS

This Response is submitted in reply to the Office Action dated November 22, 2005. Claims 2-4 and 10-13 are pending in the patent application. Claims 10 and 11 have been amended. No new matter has been added by any of the amendments made herein.

The Office Action rejected Claims 2-4 and 10-13 under 35 U.S.C. § 112, first paragraph. The Office Action also rejected Claims 2-4 and 10-13 under 35 U.S.C. § 103(a). Applicants respectfully submit, for at least the reasons set forth below, that the rejections have been overcome or are improper. Accordingly, Applicants respectfully request reconsideration of the patentability of claims 2-4 and 10-13.

The Office Action rejected Claims 2-4 and 10-13 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner was unable to locate any reference to "means occurs independently of the reading of the utility-history" in the original specification. Applicant respectfully submits that support for the above limitation is provided at least by Page 30, Lines 13-19:

In this way, the information of the sum of money, the card number, and the date/time is accumulated in the electronic money terminal device 25_x as the utilization history each time the IC card 50 is used; the electronic money management part 10 captures the utilization histories of the IC card 50 which have been accumulated in the respective electronic money terminal devices 25_x (25₁ to 25_n) one a day, collectively.

At least this paragraph of the original specification describes the gathering of the utilization-history data by the electronic money management means occurring on a schedule that is independent from electronic money terminals operatively reading the utilization-history data when said electronic money data is withdrawn from the information card. Thus, applicant respectfully requests that the rejection for lack of written description be withdrawn.

Claims 3-4 and 10-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,884,271 to Pitroda ("Pitroda") in view of U.S. Patent No. 6,129,274 to Suzuki

Appl. No.09/512,425

Reply to Office Action of November 22, 2005

("Suzuki"). Applicants respectfully disagree with and traverse this rejection because Pitroda does not disclose, teach or suggest the elements of claims 3-4 and 10-13.

The Office Action states that Pitroda discloses all the elements of the claimed invention except that Pitroda does not explicitly disclose wherein the utilization-history from each of said plurality of electronic money terminal is processed within a specific electronic money terminal, wherein the gathering of the utilization-history data by the electronic money management means occurs independently of the reading of the utilization-history data and withdrawal of the electronic money data by the electronic money terminal. The Office Action further states that it is well known to process transactions and log the history of transactions with dispensing a receipt for customer (owner of the card) associated with what he/she has purchased. The Office Action also states that Suzuki discloses collecting and storing a customer's transaction history data in real-time, wherein the gathering of the utilization-history data by the electronic money management means occurs independently of the reading of the utilization-history data and withdrawal of the electronic money data by the electronic money terminal.

The Office Action states that it would be obvious to one of ordinary skill in the art at the time the invention was made to combine Pitroda and Suzuki; however, the Office Action did not present any objective evidence of motivation to make the combination. The motivation cannot come from the application, itself, so the mere fact that the Applicant's invention is advantageous does not provide motivation to combine references containing some of the invention's beneficial features. Even if the references relied upon are known in the art and combination of the references would be "well within the ordinary skill of the art at the time the claimed invention was made," a rejection based on obviousness is still improper without some objective reason to combine the teachings of the references. M.P.E.P. § 2143.01. Further, a finding of motivation to combine must be based on objective evidence of record. In re Lee, 277 F.3d 1338, 1343, 61 U.S.P.Q.2D 1430, 1433 (Fed. Cir. 2002). See also M.P.E.P. § 2143.01. For at least these reasons, Applicant respectfully submits that the combination is improper and that the rejection is overcome.

Additionally, even assuming the combination is proper, Applicant respectfully submits that the combination does not disclose or suggest the electronic money management means comparing a first set of utilization-history data gathered from a first electronic money terminal

Appl. No.09/512,425

Reply to Office Action of November 22, 2005

with a second set of utilization-history data gathered from a second electronic money terminal as described, in part, by independent claims 10 and 11 and further, as fully supported by the specification, for example, at least at page 33, lines 11-19.

Pitroda describes a universal electronic transaction card ("UET card") which is capable of serving as a number of different credit cards, bank cards, identification cards, employee cards, medical and health care management cards and the like. The UET card includes storage elements, an input interface, a processor, a display, and a communications interface. The UET card also stores transactional information to eliminate paper receipts and includes security features to prevent unauthorized use, and can be used to replace conventional currency and traveler's checks, or to store and display promotional information, such as advertising and incentives. The UET and a Point of Sales device ("POS") interface with a communication interface unit ("CIU"), and one or more CIUs can communicate with a main central computer. However, utilization-history data is never gathered and compared with other utilization history data. For at least this reason, Pitroda does not disclose or suggest an electronic money management means comparing a first set of utilization-history data gathered from a first electronic money terminal with a second set of utilization-history data gathered from a second electronic money terminal as described in independent claims 10 and 11.

Suzuki describes an electronic personal shopping system for communicating between a customer's personal memory store and point-of-sale terminals in a retail facility. A customer's transaction history data is stored in particular locations in a memory of a portable, machine-readable smart card. Check-out terminals record a customer's most recent transactions in the customer's transaction history storage area to reflect the most recent purchase. A customer assistance, or kiosk terminal, is able to develop promotional and personalized greeting messages by reading and analyzing the transaction history stored in the smart card to personalize the service offered to each individual customer; however, the kiosk terminal does not read the transaction history and transfer that transaction history to a central computer for comparison with transaction histories read and transmitted by other kiosks. For at least this reason, Suzuki does not disclose or suggest an electronic money management means comparing a first set of utilization-history data gathered from a first electronic money terminal with a second set of

Appl. No.09/512,425

Reply to Office Action of November 22, 2005

utilization-history data gathered from a second electronic money terminal as described in independent claims 10 and 11.

For at least these reasons, amended claims 10 and 11 and claims 2-4 and 12-13 which depend from either of claims 10 and 11, are distinguishable from Pitroda in view of Suzuki and thus are in condition for allowance.

Claim 2 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Pitroda in view of Suzuki and further in view of U.S. Patent No. 6,317,721 ("Hurta"). Claim 2 depends from claim 10, and as discussed above, the combination of Pitroda and Suzuki, even if validly made, does not describe or suggest an electronic money management means comparing a first set of utilization-history data gathered from a first electronic money terminal with a second set of utilization-history data gathered from a second electronic money terminal as described in independent claim 10.

The Office Action states that it would be obvious to one of ordinary skill in the art at the time the invention was made to combine Pitroda and Suzuki; however, the Office Action did not present any objective evidence of motivation to make the combination. The motivation cannot come from the application, itself, so the mere fact that the Applicant's invention is advantageous does not provide motivation to combine references containing some of the invention's beneficial features. Even if the references relied upon are known in the art and combination of the references would be "well within the ordinary skill of the art at the time the claimed invention was made," a rejection based on obviousness is still improper without some objective reason to combine the teachings of the references. M.P.E.P. § 2143.01. Further, a finding of motivation to combine must be based on objective evidence of record. In re Lee, 277 F.3d 1338, 1343, 61 U.S.P.Q.2D 1430, 1433 (Fed. Cir. 2002). See also M.P.E.P. § 2143.01. For at least these reasons, Applicant respectfully submits that the combination is improper and that the rejection is overcome.

Additionally, even assuming the combination is proper, Applicant respectfully submits that the combination does not disclose or suggest the electronic money management means comparing a first set of utilization-history data gathered from a first electronic money terminal with a second set of utilization-history data gathered from a second electronic money terminal as described in independent claim 10.

Appl. No.09/512,425

Reply to Office Action of November 22, 2005

Hurta describes a smartcard, a smartcard based transponder, RF communications and wireless transactions. Further, Hurta describes incrementing transaction numbers each transaction so that it can be determined whether transaction has been missed or potential fraud is occurring (e.g., a transaction number occurs twice). However, the card readers do not read the transaction history and transfer that transaction history to a central computer for comparison with transaction histories read and transmitted by other card readers.

For at least this reason, Hurta does not disclose or suggest an electronic money management means comparing a first set of utilization-history data gathered from a first electronic money terminal with a second set of utilization-history data gathered from a second electronic money terminal as described in independent claim 10.

For the foregoing reasons, Applicants respectfully request that the present application is in condition for allowance and earnestly solicit reconsideration of same.

Respectfully submitted,

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